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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,653	12/30/1999	RONALD M. SMITH	42390.P6384	6654

7590

04/20/2005

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/475,653

Applicant(s)

SMITH ET AL.

Examiner

Haythim J. Alaubaidi

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2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6,8,11,12,15,16,20,21 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8,11,12,15,16,20,21 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This communication is a non-final Office Action in response to the RCE-Amendment filed on March 17, 2005.
2. Claims 1-26 were originally presented in this Application.
3. Claims 3-5, 7, 9-10, 13-14, 17-19, 22-24 and 26 were previously cancelled.
4. Claims 1-2, 6, 8, 11-12, 15-16, 20-21 and 25 are currently presented for examination following the RCE-amendment of March 17, 2005.
5. Claims 1-2, 6, 8, 11-12, 15-16, 20-21 and 25 are rejected under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 6, 8, 11-12, 15-16, 20-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott Corey Miller (U.S. Patent No. 6,421,707 and Miller hereinafter) in view of Pamela Sue Austin (U.S. Patent No. 6,157,924 and Austin hereinafter).

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8. Regarding Claims 1, 8, 15 and 20, Miller teaches:

in response to receiving a new email, determining, per a user profile database, if the new email matches a predetermined criterion of when to send notice of a new email (Figure 1, Element 135 and corresponding text; see also Col 4, Lines 21-23; see also Col 2, Lines 65-67 through Col 3, Lines 1-5; see also Figure 3, Element No. 395 and corresponding text; see also Figure No's 4a-c and corresponding text; see also Col 4, Lines 40-60, specifically Lines 49-52, i.e. when; see also Figure No. 4(f), Element No. 412 and corresponding text);

if the cellular phone uses GSM (Figure 3 and corresponding text, see also Figure 8 and corresponding text; see also Col 9, Lines 55-58) sending the customized notice of the new email via SMS (Figure No. 8, Element No. 721, and corresponding text);

sending the customized notice of the new email via SMTP (Figure No. 7, Element No. 711, and corresponding text); and

memory and processor (Col 3, Lines 53-65).

Miller reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the step of generating a customized noticed of the new email per the user profile database. However Miller teaches delivery format and how one of them is more appropriate then the other and how the user may select one based on a preference (Abstract, i.e. *The subscriber is then notified by the network of the message (delivery mechanism) and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber* (according to

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the user profile) *to the network*; see also Col 4, Lines 51-60; see also Col 3, Lines 33-38; see also Col 5, Lines 8-12, i.e. *providing a number of data services*; see also Col 4, Lines 49-51; see also Col 2, Lines 58-64, i.e. *Delivery system 160 includes interfaces to a variety of delivery systems*; see also Col 3, Lines 16-19, i.e. *Converter bank subsystem 180 converts an input into an appropriate delivery format prior to its delivery to the subscriber. The delivery format is advantageously specified by the subscriber*). However Austin teaches generating a customized noticed of the new email per the user profile database (Abstract; see also Figure No. 3, i.e. Element No. 80a and 80b; see also Figure 4 and corresponding text; see also Figure 4C, Element No. 58C and corresponding text.

Given the intended broad application of the Miller system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to Modify the teachings of Miller with the teachings of Austin to generate a customized noticed of the new email per the user profile database to increase the flexibility of the system by reaching a larger user community, especially when the user is able to specify more than one type of a delivery for the email in his/her profile.

Regarding Claims 2, 11, 16 and 21, Miller teaches receiving the user profile (Figure 4c; see also Col 4, Lines 41-51; see also Figure 11).

Regarding Claims 6, 12 and 25, Miller teaches secure manner (Figure 4a – 4b; i.e. *the security option on the top tool bar*).

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***Points of Contact***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered responses should be brought to the Customer Service Window of the Randolph Building at 401 Dulany Street, Alexandria, VA 22314

*Haythim J. Alaubaidi*

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**FRANTZ COBY**  
**PRIMARY EXAMINER**

Patent Examiner  
Technology Center 2100  
Art Unit 2161  
April 7, 2005